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AUG 18 2004

OFFICE OF PETITIONS

In re Application of :
Sheabar and Stomp :
Application No. 09/900,057 :
Filed: July 6, 2001 :
Attorney Docket No. 4532660/29930 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed July 6, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to file a proper reply to the final Office action mailed November 4, 2003, which set a statutory period for reply of three (3) months from its mailing date. An amendment was filed on January 7, 2004 (certificate of mailing dated January 5, 2004), however, the amendment failed to place the application in condition for allowance. The application became abandoned on May 5, 2004. See MPEP 706.07(f). A Notice of Abandonment was mailed on July 14, 2004.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

¹As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (1) above.

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”³

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁴

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁵

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁶

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁷

³*Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also *Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

⁴*Commissariat A L’Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵*Haines v. Quigg*, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing *Camp v. Pitts*, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); *Beerly v. Dept. of Treasury*, 768 F.2d 942, 945 (7th Cir. 1985); *Smith v. Mossinghoff*, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁶*Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷*Id.*

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts the examiner did not receive the amendment filed January 7, 2004, until after the expiration of the statutory period for reply.

With regard to item (1) above, the examiner assigned to the application has determined that the amendment filed January 7, 2004, failed to place the application in condition for allowance. This decision was noted in an Advisory Action mailed June 1, 2004. A proper response to the final Office action must be filed before a petition under 37 CFR 1.137 can be considered grantable. A proper response would be either an amendment that places the application in condition for allowance, a Request for Continued Examination, or a Notice of Appeal.

Relative to petitioner's argument that the delay in responding to the final Office action was unavoidable because the amendment was not considered until after the expiration of the statutory period for reply, it may be argued that petitioner had an obligation to file a proper response to the final Office action before the expiration of the statutory period for reply notwithstanding the Office's apparent delay in considering the amendment. Certainly, the delay in the Office's consideration of the amendment is regrettable, however; this delay did not relieve petitioner of the responsibility of filing a proper reply to the Final Office action within the allowed statutory period, whether that response be in the form of a Notice of Appeal, amendment and/or a Request for Continued Examination. Further, the delay in filing a proper response to the final Office action cannot be considered unavoidable because petitioner always had the option of filing a Request for Continued Examination to be considered in the alternative if the amendment filed January 7, 2004, failed to place the application in condition for allowance. The petition, is therefore, dismissed.

⁸See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,330.00 for a large entity and \$665.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.


The petition under 37 CFR 1.78 filed January 7, 2004, is noted, however; the petition under 37 CFR 1.78 will not be considered until application is revived and returned to a pending status.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703) 308-6916
 Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned (703) 305-0010.


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